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Serial No. : 09/407,402
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Inventors : Natesan & Gilman
For : Chimeric Transcription Factors

Art Group: 1632

Examiner: Shukla, Ram

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Commissioner for Patents
PO Box 1450
Alexandria, Va 22313-1450

September 11, 2003

Response to Notice of Non-Compliant Amendment

Sir:

This is in Response to the Notice of Non-Compliant Amendment mailed on 8/14/03 and is being timely filed prior to the due date of 9/14/03. Although no fee is believed due in connection with this filing, should any such fee be due, applicants hereby authorize the Commissioner to charge it to Deposit Account No. 01-2315.

Preliminary Remarks begin on page 2 of this paper.

Amendment and Remarks taken from our 7/29/03 Response begin on page 3 of this paper.

A Listing of Claims is included as an attachment following page 3 of this paper.

Mailing Certificate

I hereby certify that this paper is being deposited with the United States Postal Service "First Class Mail" on the date indicated below and is addressed to: Commissioner for Patents, PO Box 1450, Alexandria, VA, 22313.

date: September 11, 2003

Sue Wilson
Sue Wilson

Preliminary Remarks

Applicants reproduce below the remarks set forth in their 7/29/03 Response and include a Listing of Claims to comply with the new guidelines. As indicated in the Listing, we believe that claims 1 – 5, 31 and 39 – 51 are now pending. However, based on the rationale set forth below, applicants request that upon a finding of patentable subject matter, the remainder of claims 1 – 38 be rejoined and examined with the now pending claims. The Listing of Claims replaces all prior versions of the claims.

Amendment and Remarks [from 7/29/03 Response]

Applicants apologize for the oversight in failing to address the §112, second paragraph issues raised in the last Office Action, and thank the Examiner for the opportunity to correct this.

The word "containing" was cited as the basis for a §112, 2d paragraph rejection on the grounds that it is unclear whether an open or closed meaning is intended. Replacement with "comprising" or "consisting of" was suggested. Applicants respectfully traverse that ground for rejection, since "containing" is an acceptable and accepted term for use in claims and is synonymous with "comprising". Accordingly, no amendment is required. See MPEP 2110.3 Transitional Phrases:

The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 229 USPQ 805 (Fed. Cir. 1986); *In re Baxter*, 656 F.2d 679, 686, 210 USPQ 795, 803 (CCPA 1981); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948)("comprising" leaves "the claim open for the inclusion of unspecified ingredients even in major amounts").

Claims 39, 40 and 49 – 51 have been amended (see attached) to replace the "capable of" terminology. The language change is being made solely to advance prosecution, rather than in acquiescence to the position taken in the Office Action, and no change in meaning is intended by the amendment. These amendments should, however, render moot the remaining §112, 2d paragraph issue.

Conclusion

Again, applicants appreciate the Examiner's time and thought on this important case. The case is now considered to be in condition for allowance, which is respectfully requested at this time. If it might be helpful in answering any questions or otherwise advancing prosecution, applicants again invite the Examiner to call their attorney at the number provided below in the hope that agreement can be reached on the allowance of the pending claims.

Respectfully submitted,



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